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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/563,789

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Susanne Hader

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04/09/2009

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EXAMINER

DICUS, TAMRA

ART UNIT

PAPER NUMBER

1794

MAIL DATE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/563,789	<b>Applicant(s)</b> HADER, SUSANNE	
	<b>Examiner</b> TAMRA L. DICUS	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-24 is/are pending in the application.
- 4a) Of the above claim(s) 18 and 19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-17 and 20-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>02/27/2006, 01/06/2006</u> .                                  | 6) <input type="checkbox"/> Other: ____.                          |

## DETAILED ACTION

### *Election/Restrictions*

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 11-17 and 20-24 drawn to Decorative element.

Group II, claim(s) 18-19, drawn to process for producing a decorative element.

The inventions listed as Groups I and II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The special technical feature does not provide a contribution over the prior art because the special technical feature (namely the decorative laminate structure as recited in claim 1 having transparent adhesive foil, image pattern, and covering) is disclosed in USPN 5,518,561 to Rosa et al.

During a telephone conversation with Ed Weis on March 25, 2009 a provisional election was made without traverse to prosecute the invention of I, claims 11-17 and 20-

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24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 18-19 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double

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patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-17 and 20-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 11 recites “decorative element with a translucent substrate and an image pattern applied thereto”, it is not clear where the preamble is, normal language includes “comprising”. It is not clear if this is a composition or a composite further comprising a foil layer (see PERMATRANS™ adhesive, similar or the same as described in Applicant’s instant specification, page 6, line 5). Additionally, claim 13 recites “made of”, which would be clear if the language is “further comprising” if it is in addition to the transparent foil already mentioned in claim 11. Claims using "made of" normally implies a composition and not a structure.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11 and 15-16 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,518,561 to Rosa.

Decorative element (day-night graphics assembly, Figs. 2 and 5) disclosed by Rosa comprises in this order: translucent substrate 24 (panel, Fig. 5, see at least 5:10-20), a substrate covered by adhesive (20, Fig. 5, of PERMATRANS<sup>TM</sup> adhesive, similar or the same as described in Applicant's specification, page 6, line 5, and thus considered equivalent to a bilaterally adhesive transparent foil), image pattern (46, Fig. 5) covered by adhesive 20 (see two layers of said adhesive on either side of plastic 50-bilateral and also containing a foil because it is thin) and covering the image 46 is a translucent substrate 18. The reference is anticipatory.

Re claims 15-16, Size (shape) of an article ordinarily is not a matter of invention. The size and shape recitations are all deemed matters of choice involving differences in degree and/or size and are not patentable distinctions. In re Rose, 105 USPQ 237.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,518,561 to Rosa in view of US 6,555,193 to Cupina.

The Rosa reference essentially teaches the claimed invention.

The reference fails to teach explicitly a glass substrate (claim 12).

Cupina, for decorative elements, teaching PERMATRANS<sup>TM</sup> adhesive as well (see 4:40-56, see the adhesive on both sides-bilateral, because peelable protective film 10 is thin, it is considered a transparent foil), on any plastics or glass substrate so long as it supports the adhesive. See further at least col. 3 and abstract.

The Rosa reference does teach PERMATRANS adhesive on a panel in general, with no specific mention to a material other than being optically transparent, therefore there would be a reasonable expectation of success to modify the prior art to arrive at the instantly claimed. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Rosa's invention to include glass because Cupina discloses specific materials used as substrates in the application of decorative elements as set forth above.

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Claim 13-14, 17, 20-21, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,518,561 to Rosa solely as applied to claim 11, and Rosa in view of US 6,555,193 to Cupina, as applied to claim 12, and further in view of US 5,082,703 to Longobardi.

Rosa and Cupina combination is relied upon above.

The combination is silent to an image foil or UV protection layer (claims 13 and 20).

Longobardi teaches a concept known for decorative elements that include indicia on transparent foils having translucent UV acrylic or epoxy and enamel (synonymous with lacquer-16, Fig. 3) applied on the entire substrate foil or sheet 28 (Abstract, col. 1, 2:60-68, 3:15-25, col. 4, col. 5).

It would have been obvious to one having ordinary skill in the art to have modified the combination to include an image foil because Longobardi teaches ink on foil (image foil) to yield a certain appearance.

In view of the forgoing, the above claims have failed to be patently distinguishable over prior art.

### *References of Interest*

The remaining references listed on form(s) 892 and/or 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the rejection above.



*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. Lawrence Tarazano/  
Supervisory Patent Examiner, Art Unit 1794

Tamra L. Dicus /TLD/  
Examiner  
Art Unit 1794

March 27, 2009

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/Bruce H Hess/  
Primary Examiner, Art Unit 1794